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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/708,566  | 03/11/2004  | Manish K. Deliwala   | 60655.8900                      | 2565                        |
| 66170   | 7590        | 06/16/2010           |                                 |                             |
| Snell & Wilmer L.L.P. (AMEX)<br>ONE ARIZONA CENTER<br>400 E. VAN BUREN STREET<br>PHOENIX, AZ 85004-2202 |             |                      | EXAMINER<br>OBEID, FAHD A       |                             |
|   |             |                      | ART UNIT<br>3627                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>06/16/2010 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM  
DMIER@SWLAW.COM  
JESLICK@SWLAW.COM

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/708,566 | <b>Applicant(s)</b><br>DELIWALA ET AL. |  |
|                              | <b>Examiner</b><br>FAHD A. OBEID     | <b>Art Unit</b><br>3627                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, and 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Application***

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/02/2010 has been entered.

#### ***Preliminary Remarks***

2. This is in reply to communication filed on 06/02/2010.
3. Claims 5 and 12 have been cancelled.
4. Claims 1-4, 6-11, 13-17, and 20 have been amended.
5. Claims 21-22 have been added.
6. Claims 1-4, 6-11, and 13-22 are currently pending and have been examined.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 6-11, and 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1 and 21-22 recite the limitation “allocating, by the computer based system, billing to an internal structure...ect.” is vague and indefinite. It is confusing and unclear whether the allocated billing data refers to the descriptive data or the value driver data. It is also unclear how can billing be allocated if the computer based system did not receive any billing data. Thus the limitation is not positively recited.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**11. Claims 1-4, 6-11, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane (US 6,125,354) in view of Peterson (US 7,020,628).**

12. Regarding Claim 1: MacFarlane discloses a method comprising:

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- receiving, by a computer based system for allocating billing, data corresponding to usage of a technology resource by a group within the entity, wherein the group is assigned a distinct group identifier (*fig.1 reference characters 108-122*), and wherein a business model file of an entity comprises internal structure information including a list of a plurality of groups within the entity, and wherein the group is part of the plurality of groups (col 1 lns 27-42, col 2 lns 58-67, col 3 lns 20-26, col 3 lns 54-63);
- receiving, by the computer based system, value driver data (*re-price parameters/miscellaneous charge*) associated with the group (figs.1,4,&5; col 6 lns 57-64);

MacFarlane does not explicitly disclose that a usage is assigned a unique task identifier, receiving descriptive data corresponding to the unique task identifier, and allocating billing based on usage.

However, Peterson does teach a service bureau storing the starting and ending time stamps in a memory, wherein the starting and ending time stamps are associated in a user log with a list of authorized users, so that the user log contains a record of computer time usage for each authorized user (col 4 lns 5-10).

Peterson teaches a user log “unique task identifier” for use by a billing computer to generate bills (abstract). Maintaining a list of host computer networks and associated list of authorized users for each network, creating a starting and ending time stamp for remote access calls, transmitting the starting and ending time stamps in the user log to a billing computer in addition to other billing information, and generating a billing summary of costs and usage at the billing computer (col 5 lns 18-24)

Peterson teaches a bill may be generated that breaks up authorized users into various departments to which they are assigned within an organization. For each authorized user in the department a predetermined group of information may be displayed. The information may include the cost of long distance telephone usage which is distributed among authorized users based on the amount of time a user was communicating with the host computer network (col 4 lns 50-60). Furthermore, Peterson teaches a billing computer may generate monthly reports dividing up the usage for each individual authorized user by total time used per a given period or by time of day or week so that host computer network or service bureau resources can be properly allocated for particularly heavy usage (col 5 lns 10-15). see also (col 4 lns 35-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the host computer or computer network of the company, in addition to tracking the usage of computer time and various costs associated with that time (Peterson; col 1 lns 27-30).

13. Regarding Claim 2: MacFarlane discloses a method of claim 1, wherein the technology resource includes at least one of, telephony resource usage, manufacturing cycles, production runs, and computer usage, wherein the computer usage includes computing time obtained from an outsourced provider (col 6 lns 15-20 and col 8 lns 55-58).

14. Regarding Claim 3: MacFarlane discloses a method of claim 1, wherein receiving said business model file further includes receiving said business model file at a controller (figs 1-4,

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col 1 lns 27-42, and col 3 lns 54-63).

15. Regarding Claim 4: MacFarlane discloses a method of claim 1, further including automatically recognizing at least one user (figs. 2-4 and col 8 lns 26-34).

16. Regarding Claim 6: MacFarlane discloses a method of claim 4, wherein said allocating further includes allocating loyalty points to the at least one user (figs. 2-4 and col 8 lns 26-34).

17. Regarding Claim 7: MacFarlane discloses a method of claim 1, wherein said allocating further includes reducing said billing by a monetary value of loyalty points (figs. 2-4 and col 8 lns 26-34).

18. Regarding Claim 8: MacFarlane discloses a method of claim 1, wherein said allocating further includes at least one of transferring, pooling and gifting loyalty points (figs. 2-4 and col 8 lns 26-28).

19. Regarding Claim 9: MacFarlane discloses a method of claim 1, further including providing a descriptive billing statement including at least a portion of said business model file (fig.1, col 4 lns 45-48, and col 7 lns 10-14).

20. Regarding Claim 11: MacFarlane discloses a method of claim 1, further including adjusting said billing based upon at least one of a CPU-second used, a total CPU-seconds

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expected to be used, a volume discount, a stepped-type of pricing, a peak/off-peak usage, a geographic location, a service provided, a performance expectation, a location, a service level scoring, a CPU cycle, a local power consumption cost, a physical site security, an increased site security, an additional operational procedure needed to support increased sensitive data, a level of fail over needed, a service level agreement, and an account data privacy requirement (figs 2-4, abstract, and claim 1).

21. Regarding Claim 17: MacFarlane discloses a method of claim 13, further including performing data analysis of said computer usage using the at least one application performance driver (fig.1, col 5 lns 1-12, and claim 4).

22. Regarding Claim 18: MacFarlane discloses a method of claim 13, further including suggesting a cost efficient usage practice (col 1 lns 42-46 and col 1 lns 61-65).

23. Regarding Claim 19: MacFarlane discloses a method of claim 13, further including requesting a bid based upon said monitoring step (col 3 lns 31-40).

24. Regarding Claim 20: MacFarlane discloses a method of claim 1, wherein said business model file further includes at least one of an application profile, a value driver, a user level, a geographic area, a project, a zone, a third party provider, loyalty information and a rule (col 3 lns 31-40 and col 4 lns 1-8).



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25. Regarding Claims 10 and 13-16: MacFarlane does not explicitly disclose a computer usage includes computing time obtained from an outsourced provider, monitoring computer usage, and notifying at least one user of said computer usage.

However, Peterson does disclose a method of claim 1 wherein said technology resources includes at least one of computer usage, wherein said computer usage includes computing time obtained from an outsourced provider, telephony resource usage, manufacturing cycles and production runs (col 1 lns 17-18 and col 4 lns 7-10); Monitoring said computer usage (col 1 lns 46-50); notifying the at least one user of said computer usage (col 5 lns 10-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the computer of the company (Peterson; col 1 lns 27-29).

### ***Response to Arguments***

26. Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant argues that: a) receiving, by the computer based system, value driver data (*re-price parameters/miscellaneous charge*) associated with the group (figs.1,4,&5; col 6 lns 57-64);

In response to a) examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. MacFarlane teaches applying re-price parameters for a division within an organization (fig.1). Applying miscellaneous charges for a

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user (fig.5). The re-priced parameters are selected by the customer in connection with the rebilling procedure. If the check box is filled or activated, then the billed charges are re-billed to the desired elements of the organization (col 4 lns 55-62) (also col 8 lns 25-34.

Therefore, MacFarlane in view of Peterson still meets the scope of the limitation as currently claimed.

### *Conclusion*

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/  
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